

Application Serial No.: 09/828,341
Art Unit: 2624

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed July 26, 2005. Claims 1-35 remain pending in the present application. Reconsideration and allowance of the application and pending claims are respectfully requested.

1. **Response To Rejection of Claims 13 and 28 35 U.S.C. §112, Second Paragraph**

Claims 13 and 28 stand rejected under 35 U.S.C. §112, Second Paragraph as being indefinite. In response, the claims have been amended and are believed to overcome the rejection. Therefore, Applicants respectfully request withdrawal of the rejection.

2. **Response To Rejections of Claims 1-5, 21, and 35 Under 35 U.S.C. §102**

Claims 1-5, 21, and 35 have been rejected under 35 U.S.C. §102(e) as being anticipated by *Moscato* (U.S. Patent No. 6,335,978). Applicants respectfully traverse this rejection.

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed subject matter must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. §102(e). In the present case, not every feature of the claimed subject matter is represented in the *Moscato* reference. Applicants discuss the *Moscato* reference and Applicants' claims in the following.

a. **Claim 1**

As provided in independent claim 1, Applicants claim:

A system for verifying a document comprising:
first means for providing a first electronic image of a document;
second means for providing a second electronic image of a document,
said second electronic image being a scanned copy of a printed version of
said first electronic image; and
third means for comparing said first and second electronic images and
providing an output in response thereto, *wherein said output signifies
whether said printed version of said first electronic image is a successful
print and causes a prohibition of additional printed versions from being
produced if said output is signified to be a successful print.*

(Emphasis added).

Application Serial No.: 09/828,341
Art Unit: 2624

Applicants respectfully submit that independent claim 1 is allowable for at least the reason that *Moscato* does not disclose, teach, or suggest at least "wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced if said output is signified to be a successful print," as recited and emphasized above in claim 1.

Rather, *Moscato* discloses at most a system where "scanned information is fed to the print monitor where it is compared to the bitmap. . . . If the print monitor determines that there is a significant discrepancy, that data is transmitted back to the computer control which then can be used to log bad forms, generate a human recognizable signal (such as a sound or warning light), or shut down the system." Col. 1, lines 30-42 (Emphasis added). Accordingly, *Moscato* seemingly acts in response to an unsuccessful print in marked contrast with the claimed subject matter that acts in response to a successful print.

Thus, *Moscato* fails to teach or suggest "wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced if said output is signified to be a successful print." (Emphasis added). Therefore, *Muscato* does not teach or suggest at least all of the claimed features of claim 1. Therefore, claim 1 is not anticipated by *Muscato*, and the rejection should be withdrawn for at least this reason alone.

b. Claims 2-5

Because independent claim 1 is allowable over the cited art of record, dependent claims 2-5 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-5 contain all the elements and features of independent claim 1. For at least this reason, the rejections of claims 2-5 should be withdrawn.

c. Claim 21

As provided in independent claim 21, Applicants claim:

A system for verifying a printed document comprising:
a computer for providing a first electronic image of a document; a printer coupled to said computer;
a scanner adapted to scan a document printed by said printer to provide a second electronic image of said document, said second electronic image being a scanned copy of a printed version of said first electronic image; and

Application Serial No.: 09/828,341
Art Unit: 2624

software for comparing said first and second electronic images and providing an output in response thereto, *wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced if said output is signified to be a successful print.*

(Emphasis added).

Applicants respectfully submit that independent claim 21 is allowable for at least the reason that *Moscato* does not disclose, teach, or suggest at least "wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced if said output is signified to be a successful print," as recited and emphasized above in claim 21.

Rather, *Moscato* discloses at most a system where "scanned information is fed to the print monitor where it is compared to the bitmap. . . . If the print monitor determines that there is a significant discrepancy, that data is transmitted back to the computer control which then can be used to log bad forms, generate a human recognizable signal (such as a sound or warning light), or shut down the system." Col. 1, lines 30-42 (Emphasis added). Accordingly, *Moscato* seemingly acts in response to an unsuccessful print in marked contrast with the claimed subject matter that acts in response to a successful print.

Thus, *Moscato* fails to teach or suggest "wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced if said output is signified to be a successful print." (Emphasis added). Therefore, *Muscato* does not teach or suggest at least all of the claimed features of claim 21. Therefore, claim 21 is not anticipated by *Muscato*, and the rejection should be withdrawn for at least this reason alone.

d. Claim 35

As provided in independent claim 35, Applicants claim:

A method for verifying a document including the steps of:
providing a first electronic image of a document;
providing a second electronic image of a document, said second electronic image being a scanned copy of a printed version of said first electronic image; and
comparing said first and second electronic images and providing an output in response thereto, *wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed*

Application Serial No.: 09/828,341
Art Unit: 2624

versions from being produced if said output is signified to be a successful print.

(Emphasis added).

Applicants respectfully submit that independent claim 35 is allowable for at least the reason that *Moscato* does not disclose, teach, or suggest at least "wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced if said output is signified to be a successful print," as recited and emphasized above in claim 35.

Rather, *Moscato* discloses at most a system where "scanned information is fed to the print monitor where it is compared to the bitmap. . . . If the print monitor determines that there is a significant discrepancy, that data is transmitted back to the computer control which then can be used to log bad forms, generate a human recognizable signal (such as a sound or warning light), or shut down the system." Col. 1, lines 30-42 (Emphasis added). Accordingly, *Moscato* seemingly acts in response to an unsuccessful print in marked contrast with the claimed subject matter that acts in response to a successful print.

Thus, *Moscato* fails to teach or suggest "wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced if said output is signified to be a successful print." (Emphasis added). Therefore, *Muscato* does not teach or suggest at least all of the claimed features of claim 35. Therefore, claim 35 is not anticipated by *Muscato*, and the rejection should be withdrawn for at least this reason alone.

3. Response To Rejections of Claims 6-20 and 22-34 Under 35 U.S.C. §103

Claims 6-8 and 22-24 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Muscato* in view of *Bolle* (U.S. Patent No. 5,963,656). Claims 9 and 25 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Muscato* in view of *Bolle* in further view of *Yamaguchi* (U.S. Patent No. 5,390,003). Claims 10-20 and 26-34 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Muscato* in view of *Yamaguchi*.

It is well-established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly or explicitly, all elements/features/steps of the claim at issue. *See, e.g., In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and

Application Serial No.: 09/828,341
Art Unit: 2624

In re Keller, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Applicants respectfully traverse these rejections.

Applicants submit that *Muscato* does not teach or suggests all of the claimed features of independent claims 1 and 21, as previously discussed. Further, the Office Action fails to introduce and cite art that cures the deficiencies of the *Muscato* reference. Thus, claims 6-20 and 22-34 (which depend from respective independent claim 1 and claim 21) are allowable over *Muscato* for at least this reason.

Further, Applicants respectfully submit that *Bolle* does not teach or suggest the feature of adding a fingerprint to a printed version of an image as described in the claims. The *Bolle* reference appears to be directed toward actual human fingerprint imaging analysis, while claimed subject matter is directed towards marking images. Therefore, Applicants respectfully submit that a *prima facie* case of obviousness has not been made with regard to claims 6-9 and 22-25 for at least this reason.

In addition, Applicants respectfully submit that *Yamaguchi* does not teach or suggest the feature of disabling a print operation in a manner described by the claims. For example, the *Yamaguchi* reference does not appear to disable a printer. Rather, it "write[s] a character of "invalid" on the copy sheet when the original document has a copy-prohibited image." Col. 12, lines 12-19. Therefore, Applicants respectfully submit that a *prima facie* case of obviousness has not been made with regard to claims 10-20 and 26-34 for at least this reason.

Therefore, the rejections of claims 6-8 and 22-24 should be withdrawn for at least the aforementioned reasons.

Application Serial No.: 09/828,341
Art Unit: 2624

CONCLUSION

For at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,



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